REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of the Claims

Claims 1-27 were pending in the present patent applications. By way of this reply, claim 5 has been cancelled without prejudice or disclaimer. Accordingly, claims 1-4 and 6-27 are currently pending in the present application. Claims 1 and 17 are independent. The remaining claims depend, either directly or indirectly, from claims 1 and 17.

Claim Amendments

Claims 1 and 17 have been amended for clarification. No new matter has been added by way of these amendments, as support for these amendments may be found, for example, on page 9, lines 18-25 of the Instant Specification.

Specification Amendments

Selected lines on pages 7, 9, 10, and 12-17 have been amended to correct typographical errors. No new matter has been added by way of these amendments, as support for these amendments may be found, for example, in Figure 2.

Objection to the Abstract

The abstract has been amended to comply with the guidelines set forth under 37 CFR §1.72. Accordingly, withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C. §102

Claims 1 and 17 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,999,811 issued to Molne (hereinafter "Molne"). By way of this reply, claim 5

has been cancelled and therefore, the rejection is moot as to that claim. With respect to the remaining claims, for the reasons set forth below, this rejection is respectfully traversed.

Molne discloses a preferred roaming list that identifies and prioritizes networks to which a mobile telephone can connect. This list is maintained at a predetermined memory location in the subscriber identity module (SIM) of the mobile telephone, and the mobile telephone connects with the highest ranked network on the list. (*See* Molne: column 3, lines 1- 6 and lines 31-32). In other words, Molne is focused on a SIM switching network identities. (*See* Molne column 3, lines 21-45). However, Molne does not teach or suggest the SIM switching subscriber identities depending on the network to which the mobile telephone is connected.

Amended independent claims 1 and 17 of the present invention recite, in part, a SIM having two subscriber identities: a first subscriber identity for a first telecommunications network, and a second subscriber identity for a second telecommunications network. Further, amended independent claims 1 and 17 recite, in part, the SIM switching subscriber identities depending on the network to which the mobile telephone is connected. Thus, independent claims 1 and 17 are patentable over Molne. Claims 2-4, 6-16, and 18-27 depend, either directly or indirectly, from claims 1 and 17 and are patentable for at least the same reason. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 98/10614 (hereinafter "Rudolf") in view of EP-A-0 779753 (hereinafter "ATT"). By way of this reply, claim 5 has been cancelled and therefore, the rejection is moot as to that claim. With respect to the remaining claims, for the reasons set forth below, this rejection is respectfully traversed.

As an initial note, Applicant respectfully asserts the claims in the present application are significantly amended from the claims pending in the International Patent Application PCT/FR00/00423. Accordingly, asserting the same rejection proffered in the International Preliminary Examination Report (IPER) by the Examiner is improper. However, even assuming *arguendo* the rejections in the IPER still apply, for the reasons set forth below, these rejections are respectfully traversed.

ATT teaches a method for a wireless device to select a preferable wireless service provider in a multi-service provider environment by dividing the frequency spectrum into numerous bands, locking onto the strongest signal within each band, and then selecting a preferred service provider from the group of the strongest signals (*See* ATT: Abstract, Figure 5). Amended independent claims 1 and 17 of the present invention recite, in part, "...automatically identifying the subscriber identification module on the first telecommunication network under the first subscriber identity whenever the mobile telephone station is in the coverage field of the first telecommunication network, irrespective of the coverage of said mobile telephone station by said second telecommunication network". In view of ATT, should the first telecommunication network and second telecommunication network both operate at frequencies within the same frequency band, the telecommunications network with the strongest signal

would be selected from that band. There is *no* guarantee that the first telecommunication network will have a signal strength greater than the second telecommunications network. Thus, it is possible the second telecommunications network would be selected even if the first telecommunications network was available, squarely contradicting amended independent claims 1 and 17. Further, ATT is silent on the SIM having two subscriber identities as recited in claims 1 and 17 of the present invention.

Rudolf discloses a telecommunications process enabling a subscriber in a Home Public Land Mobile Network ("first telecommunications network") to connect to a Visitor Public Land Mobile Network ("second telecommunications network") without a roaming agreement with the first telecommunications network. However, Rudolf is silent on the scenario when a mobile telephone is using the second telecommunications network and the first telecommunications network becomes available (*i.e.*, the networks overlap). Therefore, Rudolf, like ATT, does not teach "...automatically identifying the subscriber identification module on the first telecommunication network under the first subscriber identity whenever the mobile telephone station is in the coverage field of the first telecommunication network, irrespective of the coverage of said mobile telephone station by said second telecommunication network". Thus, Rudolf does not teach all limitations of amended independent claims 1 and 17.

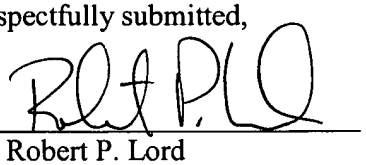
In view of the above, Rudolf and ATT, whether viewed separately or in combination, fail to teach or suggest all the limitations of amended independent claims 1 and 17. Therefore, claims 1 and 17 are patentable over Rudolf and ATT. Claims 2-4, 6-16, and 18-27 depend, either directly or indirectly, from claims 1 and 17 and are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/006001).

Dated: April 13, 2005

Respectfully submitted,

By 

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Attachments